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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,394	10/20/2003	Sylvain Rault	SERVIER 412	2877

7590 06/28/2004

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EXAMINER
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SHAMEEM, GOLAM M

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/689,394

**Applicant(s)**

RAULT ET AL.

**Examiner**

Golam M M Shameem

**Art Unit**

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-28 is/are pending in the application.
- 4a) Of the above claim(s) 26-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 15-25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

#### ***Priority***

Claim of foreign priority under 35 U.S.C. § 119(a)-(d) to France 02.13194  
10/23/2002 is acknowledged.

#### ***Status of Claims***

Claims 15-28 (currently amended) are pending in the application.

Receipt is acknowledged of amendment / response filed on June 14, 2004 and that  
has been entered.

Claims 26-28 are withdrawn from further consideration pursuant to 37 C.F.R.  
1.142 (b) as being drawn to a non-elected subject matter.

#### ***Response to Election/Restriction***

In response to the restriction requirement, Applicants have elected Group I, which  
includes claims 15-25 drawn to a compound and composition of the formula (I), and  
elected the species found in Example 6 (Remarks, page 2), on page 11, of the  
specification with traverse is acknowledged. The traversal is on the ground(s) that all the  
pending claims should be rejoined and examined with the elected Group I because “that  
a chemist would not find the instant invention to involve structurally distinct invention”  
(Remarks, page 1) and therefore a search and examination of the entire Markush group  
should be made without a serious burden.

The Examiner respectfully disagrees with the Applicants because the products of  
Invention groups I-II differ materially in structure and in element from each other and  
therefore, are capable of supporting their own patents. The invention groups I-II are  
related to a set of structurally diverse compounds, and their methods of use (chemical

Art Unit: 1626

structures, which are similar, are presumed to function similarly, whereas chemical structures that are not similar are not presumed to function similarly), which do not possess a substantial common core wherein a reference anticipating one would not necessarily render the other obvious and to search all the above groups in a single application would be an undue burden on the Examiner. Because of the plethora of classes and subclasses in each of the Group, a separate search considerations are involved, which would impose a serious burden on the Examiner to perform a complete search of the defined areas if unrestricted. Also the fields of search are not coextensive. The wide disparity among the groups requires that many divergent fields must be searched, including all classes and subclasses of U.S. and foreign patents as well as journals and publications. Moreover, the Examiner must perform a commercial database search on the subject matter of each group in addition to a paper search, which is quite burdensome to the Examiner. However, Examiner may reconsider to rejoin method of use claims commensurate in scope with the product claims when the case would be found in condition for allowance [provided those method claims are free from 35 U.S.C. §112 first (including written description, reach-through claim language and/or scope-enablement issues) and second paragraphs]. For these reasons, Applicant's arguments are found unpersuasive and, therefore, the requirement for restriction and election of species is still deemed proper and is therefore made FINAL.

Applicants preserve their right to file a divisional on the non-elected subject matter.

Art Unit: 1626

As set forth in the restriction requirement and an election of a single compound (or set of compounds), the invention will encompass all compounds that fall within the scope of the claim is as follows:

A compound having the formula (I) wherein:

R<sup>1</sup> is limited to 5-membered heteroaryl group,

R<sup>2</sup> is as claimed,

R<sup>3</sup> is as claimed, and

R<sup>4</sup> and R<sup>5</sup> are limited to hydrogen, halogen, alkyl or polyhaloalkyl (other variables such as R<sup>10</sup>, R<sup>11</sup>, X and Y etc do not apply as they are beyond the scope of elected compound and treated as non-elected inventions).

As a result of the election and the corresponding scope of the compound identified, claims 26-28 and the remaining subject matter of claims 15-25 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn subject matter of claims 26-28 is properly restricted as it differs materially in structure and in element from the elected subject matter supra so as to be patentably distinct there from.

### ***Objections***

Claims 15-25 (currently amended) are objected to for containing non-elected subject matter. The claims should be amended to exclude non-elected subject matter and within the scope of elected compound.

Claim 15 (currently amended) is also objected to for containing redundant description (beginning at line 21, page 1 through line 21, page 2) of different

Art Unit: 1626

substitutions such as “alkyl”, “alkoxy”, and “alkylene” etc from the specification. It is suggested to delete those descriptions.

The reference cited on the PTO-892 is included only to show the state of the art.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) “Official” for papers that are to be entered into the file, and “Unofficial” for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the

Art Unit: 1626

applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.

A handwritten signature in black ink, appearing to read "Golam M M Shameem". The signature is fluid and cursive, with the first name "Golam" and last name "Shameem" clearly distinguishable.

Golam M M Shameem, Ph.D.  
Patent Examiner  
Art Unit 1626, Group 1600  
Technology Center 1

June 24, 2004